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In re Application of :
Richard P. Betycky et al :
Serial No.: 10/607,571 : PETITION DECISION
Filed: June 26, 2003 :
Attorney Docket No.: 2685.2046 :

This is in response to the petition under 37 CFR 1.181, filed August 9, 2006, requesting withdrawal of the Final rejection. Applicants assert and provide a copy of an essentially identical petition filed June 6, 2006, which was either not received by the Office or improperly processed and lost by the Office.

BACKGROUND

A review of the file history shows that the examiner mailed a first Office action to applicants on September 9, 2005, acting on claims 140-173. Claims 146-150 were rejected under 35 U.S.C. 112, second paragraph, as indefinite. Claims 140, 145-147, 149, 151, 156-158, 160, 163-168 and 170-171 were rejected under 35 U.S.C. 102(b) as anticipated by Radhakrishnan. Claims 140, 145-147, 151, 156-158, 160, 163-168 and 170-171 were also rejected under 35 U.S.C. 103(a) as unpatentable over Radhakrishnan for similar reasons. Claims 140-145, 151, 154-158, 161-168 and 170-171 were rejected under 35 U.S.C. 103(a) as unpatentable over Maa et al in view of the Physicians Desk Reference (PDR). Claims 148-149 were rejected under 35 U.S.C. 103(a) as unpatentable over Maa et al in view of PDR and Jakupovic et al. Claims 152-153, 159 and 169 were rejected under 35 U.S.C. 103(a) as unpatentable over Maa et al in view of PDR and further in view of Warren et al. Claims 172-173 were rejected under 35 U.S.C. 103(a) as unpatentable over Maa et al in view of Adjei et al and Dobrozsi. Claims 140-143, 145, 151, 154 and 159-160 were rejected for Obvious Double Patenting over SN 10/818,902 in view of Maa et al.

Applicants replied on January 5, 2006, canceling claim 145 and incorporating its limitation of spray drying into claims 140 as well as a new limitation for tap density of the powder. Claims 146-150 were amended to overcome the rejection under 35 U.S.C. 112. Each of the rejections was responded to in an appropriate manner.

The examiner mailed a Final Office action to applicants on April 6, 2006, in which all previous rejections except the obvious double patenting rejection were withdrawn or modified and set forth the following rejections: Claims 140-144, 154 and 156-160 were rejected under 35 U.S.C. 102(e) as anticipated by Tarara et al. Claims 152-153 and 155 were rejected under 35 U.S.C.

103(a) as unpatentable over Tarara et al. Claims 161-162 were rejected under 35 U.S.C. 103(a) as unpatentable over Tarara et al in view of PDR. Claims 140-143, 146-151, 159-160 and 162 were rejected under 35 U.S.C. 103(a) as unpatentable over Foster et al in view of Tarara et al. Claim 171 was rejected under 35 U.S.C. 103(a) as unpatentable over Tarara et al in view of Radhakrishnan. Claims 163-170 were rejected under 35 U.S.C. 103(a) as unpatentable over Tarara et al in view of Warren et al. Claims 172-173 were rejected under 35 U.S.C. 103(a) as unpatentable over Foster et al in view of Tarara et al and further in view of the Drug Information Handbook (DIH). Claims 140-143, 151, 154, 159 and 160 were rejected for Obvious Double Patenting over 10/818,902 in view of Maa et al. An interview was held with the examiner on July 11, 2006.

A Notice of Appeal was filed on July 6, 2006. An amendment was filed July 20, 2006, in which applicants proposed further amendments to claims 140, 153 and 173 and canceled claims 151-152 and 154-155 and responded to each of the rejections of record. The examiner mailed an Advisory Action to applicants on August 1, 2006, denying entry of the amendment as not placing the case in better condition for appeal and other reasons.

This petition was then filed on August 9, 2006, and includes the petition filed June 6, 2006.

DISCUSSION

Applicants' petition requests withdrawal of the Finality of the Office action mailed April 6, 2006. Applicants state that in response to the first Office action they amended claim 140, the primary independent claim by incorporating the limitation of claim 145 into it and canceling claim 145. In response the examiner withdrew all of the rejections of record except the Obvious Double Patenting rejection and set forth new rejections over newly applied references and made the action Final. Applicants' argue that this is improper relying on M.P.E.P. 706.07(a) for support. The section states that a second or subsequent action should not be made final if it includes a rejection on prior art not of record (previously applied) on any claim amended to include limitations which should reasonably have been expected to be claimed.

Applicants' argument would have perfect merit if the limitation of claim 145 only had been inserted into claim 140 since that limitation would have been reasonably expected to be claimed. By so doing claim 140 would have had the same scope as claim 145, which is why claim 145 was canceled. But claim 140 is not of identical scope as previous claim 145, as argued by applicants. Applicants inserted into claim 140 an additional limitation to tap density of the powder. This limitation appears in no previous claim and there was no reason for the examiner to expect that it would be inserted into the independent claim as a critical limitation. Because this limitation was not addressed in any reference of record the examiner was required to find additional prior art which addressed this limitation. The new art properly applied was Tarara et al.

DECISION

The petition is **DENIED**.

Applicants' remain under obligation to file an Appeal Brief within the time period set in 37 CFR 41.37(a)(1), or as extended under 37 CFR 1.136(a)

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.

A handwritten signature in black ink, appearing to read 'B. M. Kisliuk', with a stylized flourish at the end.

Bruce M. Kisliuk
Director, Technology Center 1600